In the Supreme Court
OF THE
United States

Supreme Court, U. S.
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No. 401

GROVER D. TURNBOW, C. E. GRAY and LEDERLE LABORATORIES, INC. (a corporation),
Petitioners,

vs.

FARMERS' COOPERATIVE EXCHANGE, INC., (a corporation),
Respondent.

PETITION FOR WRIT OF CERTIORARI
to the United States Circuit Court of Appeals
for the Ninth Circuit,
and
BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI
to the United States Circuit Court of Appeals
for the Ninth Circuit.

(NOTE): All emphasis herein ours, unless otherwise specified.

To the Honorable Charles Evans Hughes, Chief Justice of the United States, and to the Associate Justices of the Supreme Court of the United States:

Your petitioners, Grover D. Turnbow, C. E. Gray, as individuals, and Lederle Laboratories, Inc., a Delaware corporation, respectfully pray for a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a judgment entered by that Court on April 22, 1940 (111 F.(2d) 728), reversing the judgment and decree of the United States District Court for the Northern District of California, Southern Division (unreported).

A petition for rehearing was filed on May 22, 1940, and denied by memorandum order of the Court on June 11, 1940.

In conformity with Rule 38 of this Court a certified copy of the record, including the proceedings in the Ninth Circuit Court of Appeals, accompanies this petition.

SUMMARY STATEMENT OF MATTERS INVOLVED.

Originally there were two suits by petitioners against respondents, on two separate patents, as follows:

The first suit was for infringement of Lindstaedt patent No. 2,036,638, of April 7, 1936, application filed June 15, 1929, for "Parasiticide";

The second was predicated on infringement of Turnbow patent No. 2,091,840, of August 31, 1937, application filed September 30, 1930, for "Vermifuge".

The actions were tried in the District Court for the Northern District of California, upon an order of consolidation and upon a single record (1 R. 117).*

The District Court found all claims in issue of both patents to be valid and infringed (Decress, 1 R. 137, 1 R. 188).

Whilst respondent-defendant appealed from each lower Court decree, the Circuit Court of Appeals treated the causes as one, and rendered a single judgment. Therefore, the same procedure is followed here, and a single consolidated title is used.

Both patents are directed to "composition of matter",** known as parasiticides or vermifuges, for internal use, particularly in poultry, whereby destruction of such internal parasites as roundworms commonly infesting portions of the intestinal tract of poultry may be accomplished efficiently and without risk of the life of the fowl.

The Lindstaedt patent disclosed that substances of **colloidal nature** (for instance hide-glue, casein, peanut meal, soy bean meal, agar-agar, starch, and many others) will render normally-lethal quantities of **alkaloidal toxic substances** (such as nicotine, coniine, etc.) non-lethal, upon ingestion of the same by animals, when the toxic substances are absorbed by, and adsorbed on, the colloidal substances; and that the bond thus created between the alkaloidal toxic substance and the colloid, was such as to hold or maintian the toxic

*In record reference, the first numeral designates the volume of the record, the second number designates the page.

**For the Patent Statutes here involved, see Appendix A.

substance non-lethal during the passage of the compound through that portion of the digestive tract when if released it would kill the animal, but will permit the release of the toxic substance in active form in the digestive tract of an animal at the point inhabited by parasites sought to be destroyed, and would thereupon destroy the parasites without injury to the fowl or other animal treated. This release occurs because the admixture is undisturbed in an acid medium, such as found in the alimentary canal of an animal and in that part of the intestinal tract preceding the habitat of the parasites, but is broken down, to release the toxic substance in active form, in the alkaline medium present in the intestines where the parasites are located.

Lindstaedt disclosed at least **nine** members of the class of **toxic substances** which were suitable for the purpose, and disclosed a wide range (no less than **fourteen** members) of the class of **colloidal substances** which would serve to carry out the invention. The patentee further disclosed exact proportions, in terms of milligrams of each ingredient, required to produce the parasiticide sought.*

The Turnbow Patent taught the production of a finely divided—comminuted—form of parasiticide or vermifuge, having the chemical ingredients and characteristics earlier taught by Lindstaedt, and which could be mixed with the feed for "flock feeding", thus overcoming any necessity for manual administration or pellets or the like.

*See Appendix B for a fu ther resumé of the patent.

That the Appellate Court had no difficulty in expressing its understanding of the meaning of the term "colloid" as used in the patents is seen at the outset of their opinion (5 R. 1561), where it was said:

> "Without attempting to state technically the exact meaning of a colloid, it is sufficient here to say that a colloid is a substance which attaches to other material and which prevents the latter material from acting in the manner that it would in its free state. It is generally believed that colloidal action takes place either by adsorption or absorption, or both. Adsorption is described as the addition of a film of one substance over the surface of another, such as a film of oil over metal, and absorption is described as the filling of the pores of one material with another, such as the absorption of water by a sponge."

There is no question but that the proofs conclusively show that the advent of these inventions solved, satisfactorily for the first time, an important problem for the poultry industry, and the trial judge, who saw the witnesses and heard the evidence, so found (see Findings (1 R. 119-134), Nos. 7-17, inclusive, and 26).

In the instant case, the Circuit Court of Appeals for the Ninth Circuit held all of the claims to be invalid by virtue of the fact that since all the claims fall in the general class commonly referred to as "chemical claims", some, but not all, of said claims were directed to an admixture of ingredients which were specified by

"class", and that a patentee could not make a generic claim for a class unless he could show affirmatively that every member of that class would work.

That, we submit, contravenes established law.

They also, and, we submit, erroneously, further held that the proportions of some of such ingredients were delimited in terms of result or function* and that therefore the entire patent was void.

The Court of Appeals did not pass upon the question of infringement, nor did it consider anticipation, other than to summarize the state of the art to the point of entrance of the Lindstaedt invention in the commercial field.

THE BASIS OF THIS APPLICATION FOR WRIT.

These cases present squarely the important, unsettled and troublesome question of sufficiency (or insufficiency) of description, and of so-called "indefinite" claims, in **chemical or "composition of matter" patents,** concerning which there have been numerous conflicting and confusing decisions in the several circuits. The principles governing the proper

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*Plaintiffs stood on claims 2, 3, 6, 8, 11 and 12 of the Lindstaedt Patent, and claims 1, 2 and 7 of the Turnbow Patent. Typical of said claims were:

Lindstaedt Claim 8: "A non-lethal parasticide for internal administration for intestinal parasites, comprising the combination of a nicotine substance in a dose normally parasiticidal to said parasites, and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated, and leaving it parasiticidal to said parasites."

Turnbow Claim 2: "A medicinal compound in finely divided condition comprising agar-agar, and nicotine substance, said compound being non-toxic to fowls when given in quantities sufficient to destroy parasites of the intestinal tract."

form and substance of chemical claims has never been adequately fixed by decisions of this Court so as to enable the Patent Office, the inventor, the public, or the Courts to determine within reasonable limits when such a claim is sufficient.

The effect of the judgment of the Appellate Court in the instant cases is to undermine the generally accepted rules of interpretation of chemical claims and to create a new rule to the effect: that a chemical "class" can not be secured by a patent claim **despite the fact that a wide number of the members of the class are named in the specification of each patent and shown to be operative for the purpose in hand, and despite the fact that no member of the class has been shown to be inoperative for the ascribed purpose!**

Nevertheless, that Honorable Court announced the dictum **(without any showing of any kind that there existed any colloids that would not work)** (5 R. 1570):

> "There are a great many alkaloidal substances, and Lindstaedt and Turnbow, could not, by the simple expedient of claiming a compound of alkoloidal substances and colloidal substances, obtain a monopoly of a countless number of compounds, which could be made from these immense classes of substances."

We know of no rule which says that mere numbers alone in a class bar the claiming of a class.

No member of either class, disclosed or undisclosed, is shown by the record or in the opinion of the Circuit Court of Appeals to be inoperative for the inventor's purpose.

We respectfully submit that the established rule is (and this record is consistent with the rule) that whereas one may not as a general proposition, on discovering a **single compound which is active for a particular purpose, claim all compounds which are thus active,** nevertheless where there has been a generic discovery, as here, and **a large number of examples of ingredients capable of use in the compound are shown, as here,** and where there is no testimony to the contrary, and where it is not shown that there are some ingredients of the class incapable of such use, that it is permissible to have both generic and specific claims in the same patent.*

The Appellate Court here then continues (5 R. 1571):

> "It is clear, therefore, that what, if anything, was novel, was the discovery of how much colloidal material was necessary to carry out the function of preventing the alkaloidal substance from having a lethal effect on the subject to which the product was administered. * * *
>
> "We may assume, without so deciding, that the claims sufficiently describe the quantity of the alkaloidal substance. The quantity of colloidal substance is described only as being an amount sufficient to colloidally hold and protect against the lethal effect of the dose. Such is the exact function of the colloidal material." (5 R. 1571.)

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*"There is nothing improper * * * in first putting your claims as broadly as in good faith you can, and then * * * following them successively with narrower claims designed to protect you against possible anticipations of which you are not yet aware." *Parke-Davis and Co. v. H. K. Mulford Co.*, 189 Fed. at 102. Affirmed, 196 F. 496 (2 C.C.A.).

If that is the known function then it is difficult to see where any indefiniteness comes in.

The Court went on to say (5 R. 1571):

> "The claims here violate that rule, and are void because 'conveniently functional language at the exact point of novelty' is used. Gen. Electric Co. v. Wabash Co., supra, 371. See also: Wood v. Underhill et al., 46 U.S. (5 How.) 1, 4; The Incandescent Lamp Patent, 159 U.S. 465, 474."

And in conclusion (5 R. 1572):

> "The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances. We think the patent law is not so benevolent, and although we do not base our decision on that express ground, we mention it to refute suggestions that the issuance of a patent offers no protection to a patentee."

We submit that the Appellate Court's mass destruction of the valuable class of chemical and composition-of-matter patents is more to the public detriment than was the **upholding of that single patent** which this Court eventually found invalid in *General Electric Co. v. Wabash Co.*, 304 U.S. 364, and upon which the Appellate Court in the instant case predicated its decision. The *General Electric* case and the instant one stand on vastly different grounds as is shown post.

If that Honorable Court's view concerning generic claims in chemical cases is correct and that only claims for specific compounds may legally be obtained, then it would require every inventor of a new chemical compound to go through the entire class and test out every substance in that class, and then attempt to take out a separate patent for each combination of ingredients!

Recognizing the difficulty of any such analysis and exhaustive study or investigation, and the utter futility of acquiring adequate patent protection if the above formula was attempted to be followed, a negative rule has been set up both by the Courts and by the Patent Office to the effect that: **a generic claim is not available or permissive where it is affirmatively shown that certain members of the class will not work.** See *Incandescent Lamp* case, 159 U.S. 465; *Corona v. Dovan,* 276 U.S. 358.

No point is made by petition of the fact that no weight was given by the Circuit Court to the uncontroverted evidence of the commercial success enjoyed by the product of the patents in suit, except merely to add that it was shown as an undisputed fact that within three years after the appearance of the Lindstaedt product on the market, the sales of the prior art products had decreased to a point where petitioners' products enjoyed substantially all of the business in parasiticides and have virtually driven the prior art products from the market (table, 3 R. 1133). Ordinarily such circumstances warrant at least favorable notice. *Eibel Process Co. v. Paper Co.,* 261 U.S. 45.

QUESTIONS PRESENTED.

Upon the facts there is presented a situation wherein an inventor has discovered broadly that substances of colloidal nature will render normally lethal doses of toxic substances non-lethal, and still leave them in condition to act as parasiticides upon ingestion; the inventor going on to disclose in his patent examples, in exact terms of quantity, of products which may be employed to produce the desired result: and defining numerous members of each class—toxic substances and colloidal substances—which have been found to be satisfactory to carry out his fundamental teaching; and that none of such members are shown to be inoperative for the intended purpose:

QUERY 1. Upon such facts, can it be said that the law of the land is such that the inventor is not entitled to claim generically his invention, but must confine himself to claiming the invention only in terms of the specific substances with which he has actually worked, and in proportions only which he has actually found to be satisfactory for treatment of each of the innumerable species of the animal kingdom?

QUERY 2. Upon these facts, can it be said that the discoverer is not entitled to claim his invention in generic terms, there being no showing in the record that, prior to the work of Lindstaedt, anyone had discovered that substances of colloidal nature possessed the property of adsorbing and absorbing toxic substances in a manner to render a normally lethal dose of the latter non-lethal, while still leaving it in a form conditioned to be released where it is needed

to exert its parasiticidal value, and without the use of a capsule or like protective covering?

QUERY 3. Can it be said, further, as a broad rule, as has been done by the Ninth Circuit Court of Appeals, that chemical ingredients can not be claimed as a class, when there is not shown to be known to exist any exceptions to successful use of any member of the class?

QUERY 4. Inasmuch as the Circuit Court of Appeals for the Ninth Circuit, in addition to invalidating the claims of the patents in suit for failure to claim the inventions in terms of "specific ingredients" with which each of the inventors worked, likewise ruled that the claims were void for definition of the quantities or proportions of the ingredients in functional language or in terms of result, rather than by statement of mathematical quantities or proportions:

Is the ruling of the Ninth Circuit Court that chemical claims must define the quantities or proportions of ingredients in non-functional language—inferentially, in mathematical terms—correct, on a set of facts such as here presented; or may an inventor define the quantity or proportion of the ingredients in terms of desired results?

QUERY 5. Where the claims of a patent for a chemical combination of known substances specify the relation and character of those substances with such definiteness as is reasonable under the conditions encountered in the art to which the patent relates, do such claims comply with U.S.R.S. 4886 and 4888 (U.S.C.A. Title 35, Sections 31 and 33), even though

the specifications must be referred to for the proportions and relations of the substances employed; and particularly when the specifications are sufficient and specify the limits within which the ingredients are used; and when the Patent Office found said specifications sufficient; and when the defendant (as one "skilled in the art")* followed the patent teachings and found no difficulty in producing a commercial, competitive article?

ASSIGNMENT OF ERRORS.

The errors which petitioner will urge, if this writ of certiorari is granted, are that the Circuit Court of Appeals for the Ninth Circuit erred:

1. In holding that an inventor of a new composition of matter may not validly claim his invention in generic language.

2. In holding that chemical ingredients may not be claimed as a class, where numerous members of the class are named in the patent, and where none of such members so mentioned, nor any other members of the class, are shown to be inoperative for the purpose desired.

3. In holding that "a limited use of terms of effect or result which accurately defines the essential qualities of a product to one skilled in the art" is not permissible in chemical or composition claims, even when coupled with the designation and use of the

*Note the statutory requirement of R. S. 4888 (see Appendix A), providing for "a written description * * * in such full, clear, concise and exact terms **as to enable any person skilled in the art** or science to which it appertains", etc.

elements effective for such result, as set out in the claims of the patents in suit, thereby contravening established patent law as exemplified, for instance, by the following cases:

General Electric Co. v. Wabash Co., 304 U.S. 364, 371;

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245, 257.

4. In deciding an important question of general law in a way that is in conflict with the weight of authority.

5. In deciding an important question of patent law contrary to the weight of authority uniformly established through the decisions of this Court and other Courts for the past ninety years or more, as illustrated by the following cases:

Wood v. Underhill, 5 How. 1;

Smith v. Goodyear Dental Vulcanite, 93 U.S. 486;

Tilghman v. Proctor, 102 U.S. 707;

Cochrane v. Badische Anilin and Soda Fabrik, 111 U.S. 293;

Seabury v. Ende, 152 U.S. 561;

The Incandescent Lamp Patent, 159 U.S. 465;

Minerals Separation Ltd. v. Hyde, 242 U.S. 261;

Eibel Process Co. v. Paper Co., 261 U.S. 45;

Temco Electric Motor Co. v. Apco Manufacturing Co., 275 U.S. 319;

Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U.S. 358;

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245;

General Electric Co. v. Wabash Co., 304 U.S. 364;

Zittlozen v. Boss, 219 F. 887 (8 C.C.A.);

General Electric Co. v. P. R. Mallory & Co., 298 F. 579 (2 C.C.A.);

Douglas Pectin Corp. v. Armour & Co., 27 F. (2d) 814 (2 C.C.A.);

Allen Filters Co. v. Star Metal Mfg. Co., 40 F. (2d) 252 (3 C.C.A.);

Sun Ray Corp v. Bellows-Claude Neon Co., 49 F.(2d) 886 (6 C.C.A.);

Research Corp. v. Chase, 88 F.(2d) 353 (7 C.C.A.);

Research Products Co. v. Tretolite Co., 106 F. (2d) 530 (9 C.C.A.).

6. In reversing the decree below and holding the claims void for indefiniteness and insufficiency, in the absence of any evidence whatever to support such conclusions.

Wherefore your petitioners respectfully pray that a writ of certiorari be issued under the seal of this Court directed to the United States Circuit Court of Appeals for the Ninth Circuit commanding that Court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of said Circuit Court of Appeals had in these causes, to the end that the same may be reviewed and determined by this Court; that

the judgment of said Circuit Court of Appeals be reversed as to said patents; and that your petitioners be granted such other and further relief as may seem just and proper.

Dated, San Francisco, California,
September 4, 1940.

Respectfully submitted,

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